REMARKS

Claim 16 has been canceled without prejudice. No new matter has been introduced. Claims 1-15 and 17-20 are pending in this application. Reconsideration and entrance of the amendment in the application are respectfully requested. Applicants believe the foregoing amendments comply with requirements of form and thus may be admitted under 37 C.F.R. § 1.116(b).

Rejections under 35 U.S.C. §132 and §112

The Examiner objected to the previously filed amendment under 35 U.S.C. §132 and rejected claim 16 under 35 U.S.C. §112 as introducing new matter. In particular, the Examiner objected to the added limitation "wherein the display strip holds the bags at temperatures above 20 °C." Although applicants believe that the original specification fully supports this limitation, claim 16 has been canceled to expedite the prosecution of the instant application. Therefore, the rejections under 35 U.S.C. §132 and 35 U.S.C. §112 are moot.

Double Patenting Rejection

Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-13 of co-pending Application No. 10/430,352 (the '352 application), in view of U.S. Patent No. 6,221,448 (Baetzold). This rejection is moot with respect to claim 16 due to the cancellation of the claim. With respect to the remaining claims, the rejection is respectfully traversed.

The Examiner appears to believe that the '352 application teaches "a display strip with the recited sealant layer and packages detachable from said strip, wherein the surface of the packages are not torn or damaged when removed" and

that the remaining features claimed in the instant application would be obvious in view of Baetzold. Applicants disagree.

First, applicants would like to point out that the instant application is a continuation-in-part of the '352 application. The added matter is covered only by claim 15 and its dependent claims 17-19. Accordingly, claims 1-14 and 20 will all have the same priority date as the parent '352 application and will expire at the same time as the parent application. Thus, these claims do not present a double patenting issue and do not require a terminal disclaimer.

Second, with respect to claims 15 and 17-19, applicants submit that they recite novel and non-obvious preferred melt flow range (MFR) of ethylene-vinyl acetate copolymer 1 to about 30 g/10 min. The claimed range reflects an important aspect of the present invention. As explained in the specification, ethylene-vinyl acetate copolymer contained in the sealant layer ensures bonding of a commodities-containing bag to the sealant layer by a heat-sealing process [§0027 of the published application; all further references are to the publication]. Furthermore, elastomeric properties of ethylene-vinyl acetate copolymer allow separation of the bag from the sealant layer without a damage to the bag [§0028].

It is a discovery of the applicants that when the MFR of ethylene-vinyl acetate copolymer is less than 1, formation of sealant layer becomes difficult because melting viscosity is too high. On the other hand, when ethylene-vinyl acetate copolymer having a MFR of more than 30 is used, the bags attached to the display strip often drop when temperature inside the room rises to 30 °C or higher (§0042; Examples 8 and 9; Table 2).

The '352 application has no discussion whatsoever of MFR, much less of the specific MFR range that provides for the desired bonding/releasing properties of the display strip. Although Baetzold mentions cold seal compositions comprising

interpolymers of ethylene with a melt index of 0.1 to 150, preferably from 0.3 to 50, and more preferably from 0.7 to 10 g/10 min. (col. 7, ll. 61-67), these compositions are not used for attaching bags to a display strip, much less for preventing damage to the bags during their peeling from a display strip. Instead, the purpose of Baetzold's invention is to provide "adhesive compositions ... [that] may be coated onto a variety of substrates, resist blocking upon being supplied as a roll-good, and exhibit a wide range of bond strengths, amenable to a variety of cold seal bonding applications" (Abstract). Such teaching of the wide ranges of melt indexes (0.1-100 g/10 min) corresponding to a wide range of bond strengths would not have motivated one skilled in the art to select an ethylene-vinyl acetate copolymer having a MFR within a narrow range from 1 to 30.

Furthermore, even if Baetzold had teachings of ethylene-vinyl acetate copolymer having a MFR within 1 – 30 range, it still would not have been obvious to combine it with the '352 application. There is nothing in the '352 application or Baetzold that would have motivated one skilled in the art to apply cold seal compositions of Baetzold to the display strip of the '352 application. As discussed above, the '352 application has no indications of desirability of selecting ethylene-vinyl with a specific MFR. Baetzold does not teach an effect of MFR value on ability to form a sealant layer or to hold display bags. Therefore, without a hindsight of the instant invention those skilled in the art would not have combined the '352 application and Baetzold to arrive at the instant claim 15. Therefore, the MFR limitation recited in claim 15 is not obvious in view of Baetzold. Accordingly, applicants respectfully request the rejection of claims 1-20 under the judicially created doctrine of double patenting to be withdrawn.

Art-Based Rejections

Claims 1, 4-20 were rejected under 35 U.S.C. §103(a) over U.S. Pat. No. 6,481,184 (Junker) in view of Baeztzold and Ullmann's Encyclopedia of Industrial Chemistry (Ullman's). This rejection is moot with respect to claim 16 due to the cancellation of the claim. With respect to claims 1, 4-15, and 17-20, the rejection is respectfully traversed.

Although the examiner acknowledges that neither Junker nor Baetzold "explicitly [discuss] ... disadvantages of inadequate adhesion ...and excessive adhesion," she appears to believe that these "are well established and recognizable issues... [for] display strip applications." (pages 5-6, paragraph B). The Examiner further contends in reference to claim 20 that "the disadvantages of inadequate adhesion (e.g., premature detachment of packages, etc.) and excessive adhesion (e.g., damage or rupture of packages during removal) would be readily apparent to those of ordinary skill in the packaging art" and that "one of ordinary skill in the art would utilize known materials in order to avoid such problems in order to obtain functional display and package mounting articles." (pages 6-7 of the Office Action) Applicants disagree.

The Examiner failed to provide any evidentiary support for her proposition that the problem of inadequate/excessive adhesion was well recognized prior to the instant invention. "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP § 2144.03. "The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *Id.* Here, the Examiner herself notes that none of the cited references mentions the problem of

inadequate/excessive adhesion, yet she concludes that the problem is well recognized.

Furthermore, as stated in the attached Declaration of Yoshio Iwasaki (§4), the problem of inadequate/excessive adhesion was not recognized prior to the instant invention because nobody has considered importance of preserving the appearance of a commodities-containing bag after it is removed from a display strip. Accordingly, there was no need to optimize adhesion to ensure that the bag is reliably secured on the display strip during transporting and displaying, yet it is easily removed without a damage to the bag's surface Declaration of Yoshio Iwasaki (§5).

Additionally, there is nothing in Junker or Baetzold that would have motivated one skilled in the art to apply peelable adhesive composition of Baetzold to the display strip of Junker to arrive at the instant invention as suggested by the Examiner on page 6 of the Office Action.

As it has been discussed in the previous response, Junker is not concerned with preventing damage to the bags during their peeling from a display strip, much less with providing a special sealant layer that is (1) torn more easily than the outer surface of the bags; (2) ensures that the bags are held securely during transporting and displaying but allows a removal of the bags without damaging their outer surface; (3) contains a polyethylene layer formed between the substrate layer and the sealant layer; or (4) contains ethylene-vinyl acetate copolymer having a particular MFR. Instead, the purpose of his invention is to provide a method for inexpensive automated packaging of bags and their attachment to the display strip (col. 2, ll.12-27). An optional sealing layer of Junker is used so that "the connection to the bag can occur through hot sealing" (col. 2, ll. 55-63). The seal formed by Junker's sealing layer is not subjected to a load.

Baetzold provides peelable and sealable compositions for packaging "food and sterilizable medical device, self-seal and tamper evident envelopes, banding for paper money, napkins, and clothing; and protective packaging such as fold over "blister" packages for hardware and small parts;" "as anti-skid coatings and for release-paper free tapes such as tabless diaper tapes" (col. 11, ll.1-9). Baetzold further provides a broad range for acceptable peel strength from 0 to 2,000 g/linear inch and notes that selection of a particular peel strength "depends on the end-use application" (col. 10, lines 45-56). Baetzold, however, has no examples of using its adhesive for attaching bags to a display strip, much less examples of optimizing his compositions to ensure reliable bonding between bags and display strip and separation of bags from the display strip without a damage to the surface of the bags. Therefore, neither cited reference suggests the desirability (and thus the obviousness) of making the combination of elements proposed by the Examiner.

Examiner appears to believe that it is obvious to combine Junker and Baetzold because it is "within the general skill of a worker skilled in the art to select a known material on a basis of its suitability for the intended use as a matter of obvious design choice." (page 6 of the Office Action). But as discussed above, there is nothing in either reference that suggests use of Junker's display strips to obtain secure, yet readily separable bonding with the bags. Applicants respectfully submit that the suggestion for the combination of the references proposed by the Examiner comes only from the claimed invention itself. The skilled artisan would not have found it obvious to selectively pick and choose the separate elements and concepts from the references so as to arrive at the claimed invention without using the present claims as a guide. Such hindsight reconstruction of the invention is not a proper criteria for determining obviousness.

With respect to independent claims 9 and 15, the Examiner's comment at beginning of paragraph (C) on page 6 of the Office Action is irrelevant, because claims 9 and 15 do expressly recite the presence of polyethylene layer and specific melt index values, respectively.

With respect to claim 9 and its dependent claims, the Examiner additionally argues that the presence of a polyethylene layer is obvious in view of Ullmann's Encyclopedia of Industrial Chemistry (Ullmann's). The Examiner appears to believe that applicants recognized an advantage that "flow[s] naturally from following the suggestion of prior art." Applicants respectfully disagree.

Claim 9 and its dependent claims require a polyethylene layer formed between substrate layer and sealant layer. As explained in the specification such placement of the polyethylene layer improves strength of the strip and bonding of the substrate and sealant layers [§0056]. Corona treatment is the principal method used to enhance adhesion properties of layers within a multi-layered film (see §2.4.1 of Ullmann's). But because the sealant layer of the instant application contains an ethylene-vinyl acetate copolymer and an adhesive promoting tackifier, corona treatment cannot be used effectively. It is a discovery of the applicants that a polyethylene layer formed between substrate layer and sealant layer allows to form a reliable bonding therebetween.

Ullmann's, at best, describes composite films comprising polyethylene. Ulmann's, however, has no suggestion whatsoever of placing layers of a composite film in a particular order, much less of forming a polyethylene layer between substrate layer and sealant layer. Since the advantage of secure bonding of substrate and sealant layers does not flow naturally from a general description of Ullmann's composite films, the placement of a polyethylene layer between substrate and sealant layer as required by claim 9 is not obvious in view of Ullmann's.

Therefore, claims 1, 4-15, and 17-20 are patentable over Junker in view of Baetzold and Ullmann's.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (310) 789-5153 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

Date: December 6, 2005

By: Olga Berson
Olga Berson
Registration No. 55,001
Attorney for Applicant(s)

500 South Grand Avenue
Suite 1900
Los Angeles, CA 90071
Tel. (213) 337-6700
Fax (213) 337-6701